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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,789	08/04/2003	Curtis C. Harris	015280-225111US	6897

20350 7590 03/22/2006

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EXAMINER	
GUPTA, ANISH	
ART UNIT	**PAPER NUMBER**
1654	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/633,789	HARRIS ET AL.	
	Examiner	Art Unit	
	Anish Gupta	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 12-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-9 and 12-15* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-2, drawn to method of screening a compound for an ability to induce apoptosis, classified in class 435, subclass 7.21.

II. Claim 3-7, drawn to a method of screening for a compound capable of inhibiting the binding of p53 protein to at least XPB and XPD, classified in class 435, subclass 4+.

III. Claims 8-9, drawn to a method of screening a compound capable of inhibiting at least one XPB or XPD helicase activity, classified in class 435, subclass 4+.

IV. Claims 12 an 15, drawn to a method of diagnosing Xeroderma pigmentosum complementation group B or D in an individual, classified in class 436, subclass 86.

V. Claim 13-14, drawn to an amino acid of SEQ ID 4, classified in class 514, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

The methods of Group I-III are independent and distinct, even though they are drawn to a method of screening, because each screening method involves different method steps. For example, the method of Group I involves the use of cells undergoing apoptosis after microinjection of DNA constructs expressing wild type p53. The method involves the detection of apoptosis as the end point of screening method. The method of Group II, does not involve cells and involves a reagent of XPB and XPD. Note that the method of Group I does not require the presence of such a reagent. Further, the end point of method of Group II is the determination of binding of the compound to XPB and XPD. Finally, the method of Group III does not involve the presence of wild-type p53 and involves an endpoint to measure helicase activity. Thus, each method involves

different reagents, different method steps and different end points. Accordingly a search for each method would be substantially different and unduly burdensome.

The method of Group IV is significantly different form method of Group I, which also involves the a method of using cells, in that the method of Group IV involves obtaining cells from an individual and contacting a specific compound as claimed in the instant application. The method does not involve determining a compound capable of eliciting a desired activity. The method involves determination of a specific disorder in a specific individual. Thus, each method involves different reagents, different method steps and different end points. Accordingly a search for each method would be substantially different and unduly burdensome.

The Inventions V and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method of Group IV can be practiced with a materially different compound. For example, US 6602979 teach the use of a different amino acid, SEQ ID NO 2, sequence in diagnosing Xeroderma pigmentosum.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (571)272-0965. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can normally be reached on (571) 272-0974. The fax phone number of this group is (571)-273-8300.

3/21/06

Anish Gupta
Patent Examiner